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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/244,530	08/02/94	COLPAN	M P2650242SD

EXAMINER	
CRANE, L	
ART UNIT	PAPER NUMBER
1803	8

DATE MAILED: 02/22/95

WILLIAM E. PLAYER
JACOBSON, PRICE, HOLMAN & STERN
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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

for restriction purposes only.

☒ This application has been examined ☒ Responsive to communication filed on 06/02/94 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire ~~3~~ month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☒ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☒ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474..
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☒ Claims 1-38 are pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 1-38 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The ~~certified~~ copy has ☒ (PCT) been received ☒ (German) not been received ☐ been filed in parent application, serial no. _____ ; filed on _____.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group 1800, Art Unit 1803.

Restriction to one of the following inventions is required under 35 U.S.C. §121:

I. Claims **1-16, 32-33, 35 and 37**, drawn to a process, classified in Class 536, subclass 25.4+.

II. Claims **17-30, 31 36 and 38**, drawn to a device, classified in Class 422, subclass 70.

III. Claim **34**, drawn to "use" of nucleic acids recovered in subsequent processing, classified in Class 435, subclass 6+.

The inventions are distinct, each from the other because of the following reasons:

Inventions **I and II** are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP 806.05(e)). In this case the chromatographic apparatus can be used for the separation of oligosaccharides.

Inventions **I and III** are related as mutually exclusive species. In the instant case the first invention is directed to a process of purification of any nucleic acid and the second invention is directed to

the subsequent use of the product nucleic acid in an unrelated process. Each invention is deemed to be independently useful since there is nothing on the record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit such evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other inventions.

Inventions **II and III** are related as mutually exclusive species. In the instant case the first invention is directed to an apparatus useful in the separation of nucleic acids using multiple silica adsorbants and the second invention is the subsequent use of the product nucleic acid in an unrelated process. Each invention is deemed to be independently useful since there is nothing on the record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit such evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other inventions.

Because these inventions are distinct for the reasons given above and 1) have acquired a separate status in the art as shown by their divergent classification, 2) have acquired a separate status in the art because of their recognized divergent subject matter, and 3) the

search required for each of Groups **I, II, or III** are not required for any one of the other Groups, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. William E. Player on December 28, 1994 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is requested to note that claims **31-34** violate both 35 U.S.C. §101 and 35 U.S.C. §112 since they are each drafted in terms of "use." See *Clinical Products v. Brenner,* 255 F. Supp. 151, 149 USPQ 475 (1966). Should applicant redraft any one or all of these claims to comport with US practice, examiner reserves the right to amend the instant restriction as appropriate.

Papers related to this application may be submitted to Group 1800 via facsimile transmission(FAX). The transmission of such papers must conform with the notice published in the Official Gazette (1096 OG 30, November 15, 1989). The telephone number for the FAX machine now on-line in Group Art Unit 1803 is (703) **308-4227**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner L. E. Crane whose telephone number is 703-**308-4639**. The examiner can normally be reached between 9:30 AM and 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas W. Robinson, can be reached on (703)-308-2897.

Art Unit 1803

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1800 receptionist whose telephone number is 703-**308-0196** .

LECrane:lec

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DOUGLAS W. ROBINSON
SUPERVISORY PATENT EXAMINER
GROUP 1800